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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
SHINGLES, KRISTIE D	

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/942,615	KIMURA ET AL.	
	Examiner	Art Unit	
	Kristie Shingles	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2 and 5-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2 and 5-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 May 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/23/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant has amended claims 2 and 5-10.
Claims 1, 3 and 4 have been cancelled. Claims 11 and 12 are new.
Claims 2 and 5-10 are pending.

Drawings

1. The proposed drawing corrections filed 5/23/2005 have been accepted by the Examiner. The corrections to the drawings will not be held in abeyance.

Specification

2. The proposed specification corrections filed 5/23/2005 have been accepted by the Examiner. The corrections to the specification will not be held in abeyance.

Response to Arguments

3. Applicant's arguments filed 5/23/2005 have been fully considered but they are not persuasive. Examiner's response to Applicant's arguments follows.

A. **Regarding claims 9 and 10,** Applicant argues (see Remarks, page 11) that the cited prior art of record, *Jayant et al* (US Publication 2002/0028024) is: "not an appropriate reference to be used for anticipatory or obviousness type purposes to reject the claims of the present application being that the present application claims a priority date of April 2, 2001 which predates the effective date of July 11, 2001 of Jayant."

A.1. Examiner directs Applicant's attention to the **Related U.S. Application Data** section of the *Jayant et al* reference, where it is disclosed that the *Jayant et al* reference is related to provisional application 60/217,301 filed on July 11, 2000. Consequently, the earliest effective priority filing date of the *Jayant et al* reference is July 11, 2000, which predates the April 2, 2001 filing date of the instant application. Therefore, the *Jayant et al* reference is proper and the rejection is sustained.

B. **Regarding claims 2, 7 and 8,** Applicant argues, in substance (see Remarks, pages 13-14), that the cited prior art of record *Sahai et al* (USPN 6,594,699) fails to teach or suggest: "a multi-media conversion server including means for receiving media information transmitted by a first terminal, means for acquiring a destination of the media information received and means for acquiring media decoding capability of the second terminal which is the destination...[and]...means for converting the media information into media information corresponding to the media decoding capability of the second terminal and means for transmitting the media information corresponding to the media decoding capability of the second terminal to the second terminal".

B.1. It is the Examiner's position that *Sahai et al* teaches the above limitations as stated in the claim language, "a multi-media conversion server *comprising* (emphasis added)..." *Sahai et al* teach the server processor receiving the client processor's capabilities and converting the media based on these capabilities (Abstract, col.3 line 5-col.4 line 63), which fulfills the "means for receiving media information transmitted by a first terminal, means for acquiring a destination of the media information received and means for acquiring media decoding capability of the second terminal which is the destination...[and]...means for converting the media information into media information corresponding to the media decoding capability of the second terminal and means for transmitting the media information corresponding to the media decoding capability of the second terminal to the second terminal". Applicant argues that these limitations are not taught by *Sahai et al* because in *Sahai et al* "each

terminals informs their own capability to a server and receives data depending on the capability as has been expressed by the terminal itself to the server," wherein according to the present invention of the instant application, "the multi-media conversion server is intended to coordinate transmission between a transmitting terminal and a destination terminal...the multi-media conversion server obtains the media decoding capabilities of the destination terminal...the destination terminal need not have the intelligence necessary to inform other apparatus of its capabilities." However, the Examiner respectfully disagrees. The claim language is drawn to the means for receiving and acquiring the client device's capabilities, it does not specify in the claim language how it obtains these capabilities or whether the client device has the intelligence to inform the server of its capabilities. Nonetheless, *Sahai et al* still specify that the server can determine and receive the client device's capabilities via an application running on the client's device, via a query from the server, or they can automatically by sent with each request; and subsequently tailor the media using the appropriate software and hardware decoders based on the client machine's capabilities (Abstract, col.1 line 60-col.2 line 64, col.3 line 5-col.4 line 63). Therefore the arguments are non-persuasive and the rejection is sustained.

C. **Regarding claims 5 and 6,** Applicant argues, in substance (see Remarks, page 16) that the cited prior art or record, *Chen et al* (USPN 6,553,100) fails to teach or suggest: "means for presenting a plurality of speech types to be converted and a plurality of video types to be synthesized and instructing to select and specify each type from among the speech and video types to the first terminal...[and] the speech signal conversion means converts the character information into a speech speech signal of the selected speech type and the video synthesis means synthesizes the video signal into the selected video type."

C.1. It is the Examiner's position that, *Chen et al* teach the above limitations wherein an instruction to select the appropriate device listed by user will consequently foster the

conversion and synthesis of the appropriate media type specific to that device (col.2 lines 1-15). Because the user profiles, include the capabilities of their listed devices, the alert information can be modified to the proper format according the device selected to receive the alert information (col.3 lines 1-16). *Chen et al* further teach the synthesis of the video signal into a video type specific to the receiving device, i.e. a television or PDA (col.3 lines 43-57). The user is presented with various types of options in the form of speech, audio signals, text or video for generating the alerts—and once the type is selected and specified by the user, the alert is converted into that format for compliance with the capabilities of the user device and preferences (col.5 line 1-col.6 line 7, col.6 lines 33-67, col.7 lines 1-56, col.8 lines 2-22 and 54-67, col.9 lines 1-7, col.11 lines 1-27). Therefore Applicant's arguments are non-persuasive and the rejection is sustained.

Claim Objections

4. Claims **11 and 12** are objected to because of the following informalities: duplicate claims. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims **2, 7 and 8** are rejected under 35 U.S.C. 102(e) as being anticipated by *Sahai et al* (USPN 6,594,699).

a. **Per claim 7,** *Sahai et al* teach a multi-media conversion server comprising:

- means for receiving video information addressed to a second terminal from a first terminal (Figure 2, Col.3 Lines 5-19, Col.4 Lines 9-63 and Col.6 Lines 12-16);
- means for acquiring video format information representing a format of video information that can be received and decoded by said second terminal using an identification of said second terminal received from said first terminal (Col.3 Lines 23-60, Col.4 Lines 32-43, Col.5 Lines 36-46 and Col.6 Lines 9-16);
- means for comparing a video format of said received video information with said video format information representing a format of video information that can be received and decoded by said second terminal (Col.3 Line 50-Col.4 Line 56 and Col.5 Line 47-Col.6 Line 21);
- means for, if a video format that can be received and decoded by said second terminal is not available in said received video information as a result of the said comparison, selecting a video format that can be received and decoded by said second terminal, and converting the video format of said received video information into the selected video format (Col.6 Lines 17-42); and
- means for transmitting said video information having the converted video format to said second terminal (Col.6 Lines 42-49).

d. **Claims 2 and 8** contain limitations that are substantially equivalent to claims 7 and are therefore rejected under the same basis.

7. Claims **5-6** are rejected under 35 U.S.C. 102(e) as being anticipated by *Chen et al* (USPN 6,553,100).

a. **Per claim 5,** *Chen et al* teach a multi-media conversion server comprising:

- means for receiving character information addressed to a second terminal by a first terminal (Col.5 Lines 21-67);

- means for acquiring format information that can be received and decoded by said second terminal (Col.6 Line 54-Col.7 Line 63);

- speech signal conversion means for converting said character information into a speech signal (Col.6 Lines 40-43);

- video signal synthesis means for synthesizing a video signal corresponding to said speech signal into a synthesized video stream (Col.6 Lines 40-50, Col.7 Lines 1-56, Col.8 Lines 2-22 and 54-67, Col.9 Lines 1-7);

- speech signal encoding means for encoding said speech signal using the first information (Col.6 Line 54-Col.7 Line 63);

- video encoding means for encoding said video signal using the format information into an encoded speech stream (Col.6 Lines 33-67); and

- means for adding the encoded speech stream and the synthesized video stream to said character information, and sending such streams to said second terminal; and (Col.5 Line 51-Col.6 Line 15, Col.6 Lines 45-67 and Col.8 Line 54-Col.9 Line 7).

- means for presenting a plurality of speech types to be converted and a plurality of video types to be synthesized, and instructing to select and specify each one type from among the speech and video types to said first terminal (Col.5 Line 1-Col.6 Line 7, Col.6 Lines 33-67, Col.7 Lines 1-56, Col.8 Lines 2-22 and 54-67, Col.9 Lines 1-7, Col.11 Lines 1-27);

- wherein said speech signal conversion means converts said character into a speech signal of the selected speech type, and said video synthesis means synthesizes said video signal selected video type (Col.3 Line 43-Col.5 Line 14, Col.8 Lines 54-67 and Col.10 Lines 37-43).

b. **Claim 6** contains limitations that substantially similar to claims 5 and 7 and is therefore rejected under the same basis.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims **9-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Sahai et al* (USPN 6,594,699) and *Chen et al* (USPN 6,553,100), in view of *Jayant et al* [US 2002/0028024].

a. **Per claim 9,** *Sahai et al* teach the multi-media conversion server of claim 2, yet fail to distinctly teach in a multi-media conversion server of claim 1, a multi-media conversion service characterized in that a conversion fee that is determined based on the combination of an input media information type with an output media in formation type is charged to a transmitter. However, *Jayant et al* teach implementing a fee dependant on the type of encoding service requested by the client before displaying on the client's terminal [paragraphs 0078-0081].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Sahai et al* and *Jayant et al* for the purpose of charging a fee for the multi-media's format conversion's quality of service; because it would financially benefit and compensate the conversion providers for their services while funding the system so for it to afford enhancements and improvements to its conversion and synthesizing services.

b. **Claim 10-12** are substantially similar to claim 9 and is therefore rejected under the same basis.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: *Kikinis* (USPN 6,553,410) and *Robotham et al* (USPN 6,704,024).

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles
Examiner
Art Unit 2141

kds

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SUPERVISORY PATENT EXAMINER